REMARKS

Claims 35 and 36 are pending in this application.

Claims 35 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fischer (U.S. Patent No. 4,868,877) in view of Kuzma (U.S. Patent No. 5,771,289). Reconsideration is respectfully requested.

In the Final Rejection, the Examiner agrees that Kuzma does not disclose, teach or suggest a signed digital message or validating a signed digital message. (Office Action, page 2, first paragraph). The top of page 3 of the Office Action, however, states:

> Kuzma teaches the use of a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating the message. Thus, Kuzma teaches the concept of using a register having funds stored therein to pay for a service such as validating a message to ensure legitimacy.

As noted above, however, there is no disclosure, teaching or suggestion in Kuzma of a signed digital message or validating a signed digital message. If there is no disclosure, teaching or suggestion in Kuzma of a signed digital message or validating a signed digital message, there can not be any disclosure, teaching or suggestion in Kuzma of using a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating a message.

The Office Action contends that it would have been obvious to combine the teachings of Fischer and Kuzma, and that by combining the teachings of Kuzma and Fischer one would arrive at the present invention. Applicants respectfully disagree.

Fischer is directed to a public key cryptographic system with enhanced digital signature certification that authenticates the identity of the public key holder. Specifically, in Fischer, a trusted authority creates a digital message which contains the claimant's public key and the name of the claimant and a representative of the authority signs the digital message with the authority's own digital signature. This digital message, often referred to as a certificate, is sent along with the use of the claimant's own digital signature. Any recipient of the claimant's message can trust the signature, provided that the recipient recognizes the authority's public key. (Col. 3, lines 21-34). While Fischer discloses the use of certificates for providing security functions, there is no disclosure, teaching or suggestion in Fischer, as noted by the Office Action (page 3, line 26 to page 4, line 2), of providing payment to the certificate authority for processing, i.e., validating, the signed digital message.

Kuzma is directed to a method and apparatus for transmitting electronic data using electronic credits to pay for the transmission. In Kuzma, a transmission service provides communications links between a sender and an addressee. The sender uses electronic stamps, previously purchased from the transmission service, to pay for the transmission of the message and the use of the communications links, After preparing an electronic message for sending and selecting an addressee, the file size is examined, for example in bytes, of the data being transmitted and an electronic stamp is attached to the data transmission as payment for the transmission and/or use of the communications channel. The electronic stamp is a data packet that when processed by the carrier or at the addressee location appears as a stamp-like graphic marking on the transmitted document. Substantially concurrently with application of the electronic stamp to the electronic data, a counter or database containing the data corresponding to the sender's amount of electronic stamps is debited in an amount equal to the value of the affixed electronic stamp to reflect the use of the electronic stamp to pay for the electronic transmission of the data or message. (Col. 2, line 53 to Col. 3, line 9). To prevent fraud and theft of services of the carrier, the stamp presented as payment for a transmission can be authenticated

by hiding an authenticating mark in the stamp graphics or by including an authentication data code. (Col. 3, lines 17-44).

Thus, even if one were motivated to combine the teachings of Fischer and Kuzma, it would simply teach a method and system to pay a transmission service for the electronic transmission of the digital message created and signed by the trusted authority. Transmission of a digital message is not the same as validating a digital message. There is no disclosure, teaching or suggestion in the cited references, either alone or in combination, of a method for validating a signed digital message that includes "providing a register having funds stored therein; receiving a signed digital message from a sender; determining if sufficient funds are present in the register for validating the message; deducting funds from the register for validating the message; and validating the signed digital message using a public key of the sender" as recited in claim 35. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from these references. See Ex parte Clapp, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support and obviousness determination).

The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so). "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in a way they were combined by the inventor." ATD Corp. v. Lydall, Inc., 159 F.3d

534, 545 (Fed. Cir. 1998) (emphasis added). No such suggestion or motivation has been provided by the Office Action to arrive at the present invention from these references.

For at least the above reasons, it is respectfully submitted that claim 35 is allowable over the prior art of record. Claim 36, dependent upon claim 35, is allowable along with claim 35 and on its own merits.

In view of the foregoing remarks, it is respectfully submitted that the claims of this case are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,

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